

Claim 30 recites an adjustable keyboard tray that includes top and bottom plates secured together to form a cavity therebetween, including a plurality of inner walls along opposed facing surfaces of the top and bottom plates that are ultrasonically welded together. The Examiner has admitted that "Smeenge fails to teach the bottom plate of the tray being secured to or separable from the top plate." Thus, in order to reject claim 30 under 35 U.S.C. § 103, the Examiner turns to the teachings of Martin.

Martin discloses a keyboard tray that includes a top plate (21) and a medial plate (22) forming a cavity therebetween. See, e.g., Figure 3. The Examiner has concluded that the medial plate (22) is the "bottom plate" recited by claim 30. Martin also discloses a plurality of ribs (43) that "project from the bottom surface of the drawer assembly and extend laterally to impinge upon the channel 32 and serve as drawer guides." From Martin's disclosure of ribs (43), the Examiner contended that it would have been obvious to one having ordinary skill in the art "to have modified the top plate to have incorporated a plurality of inner walls as aught by Martin along the opposed facing surface of the top plate for the purpose of reinforcing the top plate and further improving the slidability of the mouse platform."

The rejection of claim 30 under 35 U.S.C. § 103 is improper. In order to reject a claim under 35 U.S.C. § 103 as being obvious over a combination of references, the references when combined must teach or suggest all of the claim limitations. See M.P.E.P. 2143, 2143.03, citing In re Royka, 490F.2d 981, 180 U.S.P.Q. (BNA) 580 (C.C.P.A. 1974). Here, the combination of Smeenge et al. and Martin still requires a further modification, to add ribs extending from the top plate (21) taught by Martin and to ultrasonically weld those added ribs to the ribs (43) that extend from the medial plate (22). This modification is not taught or suggested by Smeenge et al., Martin, or any other prior art of record, meaning that the combination proposed by the Examiner is lacking a limitation recited by claim 30. Thus, the rejection of claim 30 under 35 U.S.C. § 103 should be withdrawn.

The Examiner has justified the modification of the teachings of Martin (to add ribs extending from the top plate (21) and to ultrasonically weld those ribs to the ribs (43) extending from

the medial plate (22)) by contending that it would have been obvious to have modified the top plate to have incorporated a plurality of inner walls as taught by Martin along the opposed facing surface of the top plate for the purpose of reinforcing the top plate and further improving the slidability of the mouse platform.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. 2143.01. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. 2143.01, citing *In re Gordon*, U.S.P.Q. (BNA) 1125 (Fed. Cir. 1984). Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. 2143.01, citing *In re Ratti*, 123 U.S.P.Q. (BNA) 349 (C.C.P.A. 1959).

Here, the proposed modification of Martin would add ribs extending from the top plate (21) to contact and be ultrasonically welded to the ribs (43) extending from the medial plate (22). The proposed motivation for this modification is "for the purpose of reinforcing the top plate and further improving the slidability of the mouse platform." However, there is no teaching or suggestion in Martin or elsewhere in the art to make such a modification, and in fact the proposed modification would render Martin unsatisfactory for its intended purpose. Martin teaches, at column 4, lines 44-46, that the ribs (43) project from the bottom surface of the drawer assembly and extend laterally to impinge on the channel 32 and serve as drawer glides. If Martin were to be modified so that ribs extend from the top plate (21) and are ultrasonically welded to the ribs (43), the sliding path of the drawer assembly would be blocked, and the ribs (43) extending from the medial plate (22) would no longer serve as drawer glides. Thus, there can be no teaching or suggestion to modify the design of the ribs (43) of Martin as proposed, since such a modification would render the Martin

First Named Inventor: Kenneth J. Kirchhoff

Application No.: 09/665,821

-4-

design unsatisfactory for its stated, intended purpose. The rejection of claim 30 under 35 U.S.C. § 103 should accordingly be withdrawn.

Claims 31 and 32 depend from independent claim 30, and are allowable therewith, since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

CONCLUSION

In view of the foregoing, all pending claims 2-10, 12-17 and 19-32 are in condition for allowance. A Notice to that effect is respectfully requested. The Examiner is cordially invited to contact the undersigned at the telephone number listed below if such a call would in any way facilitate the allowance of this application.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: May 26, 2005

By: _____



Alan M. Koenck, Reg. No. 43,724
THE KINNEY & LANGE BUILDING
312 South Third Street
Minneapolis, MN 55415-1002
Telephone: (612) 339-1863
Fax: (612) 339-6580

AMK